OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

ATTORNEYS AT LAW

FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VIRGINIA 22202 U.S.A.

(703) 413-3000

(703) 413-2220 FACSIMILE

OBLONPAT@OBLON.COM

WWW.OBLON.COM

PATENT TRADEMARK AND COPYRIGHT LAW
AND RELATED FEDERAL AND ITC LITIGATION

July 15, 1998

Box 8
Commissioner of Patents & Trademarks
Washington, D.C. 20231

Attention: Scott A. Chambers, Associate Solicitor

Dear Mr. Chambers:

The enclosed comments address the "Request for Comments on Interim Guidelines for Examination of Patent Applications Under 35 U.S.C. §112 ¶1 "Written Description" Requirement, 63 Fed. Reg. 32639 (1998).

The comments are my own personal views, and do not necessarily represent the views of the above-referenced law firm or any of its clients.

Finally, this letter and the above-mentioned enclosure are also embodied in a 3.5" floppy disk as a single document in WordPerfect 7.0.

Very truly yours,

Harris A. Pitlick

Enclosure: Personal Comments of Harris A. Pitlick
3.5" floppy disk

Personal comments of Harris A. Pitlick

The following comments address the "Request for Comments on Interim Guidelines for Examination of Patent Applications Under 35 U.S.C. §112 ¶1 "Written Description" Requirement, 63 Fed. Reg. 32639 (1998).

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As will be discussed in further detail below, the interim guidelines should be withdrawn at worst, as an incorrect statement of the law, and at best, as premature.

The "Written Description Guidelines" (guidelines) are stated as being issued in view of University of California v. Eli Lilly, Fiers v. Revel, and Amgen, Inc. v. Chugai Pharmaceutical Co. (citations omitted). The Office asserts that the guidelines are "based on the Office's current understanding of the law and are believed to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit, and the Federal Circuit's predecessor courts."

As the Office appears to recognize, it is charged with applying the law, i.e., the US Constitution, relevant statutes, and relevant precedent of tribunals of highest authority. While the Office concludes that it is "believed" that the guidelines are fully consistent with binding precedent, it has made no analysis. As argued by this writer in Harris A. Pitlick, *The Mutation on the Description Requirement Gene*, 80 J. Pat. & Trademark Off. Soc'y 209 (1998), Lilly and Fiers do not correctly state the law regarding the written description requirement of 35 U.S.C. §112. As noted in the above article, the court in the above cases ignored the doctrine of constructive reduction to practice and, in effect, held that with regard to certain inventions in the biotechnological area, only actual reduction to practice constitutes possession of the invention with regard to satisfying the description requirement. Since the above cases are the decisions of

three-judge panels only, they cannot overrule precedent of the CCPA (which always sat in banc) or an in banc panel of the Federal Circuit. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

At note 7 of the guidelines, the Office discusses Vas-Cath, and other cases, and then concludes that "[t]hese early opinions did not address the quality or specificity of particularity that was required in the description, i.e., how much description is enough." Of course these so-called "early" opinions did not address this issue, because it is a non-issue. Under 35 USC 112, the only issue where "amount" of description is important is the enablement requirement, i.e., the statute requires a written description of the invention, and how to make and use it, "in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same (emphasis added)." So long as the invention described is claimed in the same or equivalent terms, the description requirement has always been found to be satisfied. It is clear from an analysis of all the so-called early cases on the issue that an invention claimed in the same language used to describe the invention in the originally filed disclosure, i.e., specification and original claims, has never resulted in a finding that the description requirement was not satisfied.

In sum, a three-judge panel of the Federal Circuit cannot overrule long-standing precedent that the filing of a patent application is a constructive reduction to practice of subject matter disclosed therein.

Because the Office is relying only on the decisions of three-judge panels, which decisions are inconsistent with binding precedent, the guidelines are at best premature. The Office cannot predict that the holding in Lilly, for example, will become binding precedent. Another panel of the court could conceivably arrive at a different result under a similar fact pattern. Compare

YBM Magnex Inc. v. ITC, ___ F.3d ___, 46 USPQ2d 1843 (Fed. Cir. 1998) (holding that disclosed but unclaimed subject matter is not necessarily dedicated to the public domain, contrary to the holding in Maxwell v. Baker, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996)). Indeed, YBM highlights the fact that a decision of a three-judge panel, like Maxwell, cannot overrule binding precedent. Until the Supreme Court, or an in banc panel of the Federal Circuit, or Congress, changes the law, the Office should not be publishing guidelines conflicting therewith.

If the Office believes published guidelines are necessary, the Office should instead state that constructive reduction of practice is still the law with regard to inventions claimed in the same terms as described in the disclosure, and that it will not follow cases like Lilly until binding precedent causes it to make exceptions for certain classes of inventions.